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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,758	08/21/2003	Begum Tamer	67551	8044
48940	7590	10/11/2006	EXAMINER	
FITCH EVEN TABIN & FLANNERY 120 S. LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			CHAWLA, JYOTI	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/645,758

Applicant(s)

TAMER ET AL.

Examiner

Jyoti Chawla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6, 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Amendment filed July 26, 2006 has been entered. Claims 1-5 and 7 have been cancelled and claims 6, 8, 9, 12,13, 16 and 17 have been amended and claims 21-23 have been added. Claims 6, 8-23 remain pending and are examined in the application.

#### ***Claim Rejections - 35 USC § 112***

The previous rejections regarding the Specification and 112 rejections have been withdrawn in light of applicant's amendments.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The previous 102 rejections regarding claims 1-6, 10-12, 16 and 20 have been withdrawn in light of applicant's amendments.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The previous 103 rejections regarding claims 1-6, 10-12, 16 and 20 have been withdrawn in light of applicant's amendments.

(A) Claims 6, 10-13, 16-17, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negro (US 4629628) in view of the combination of Technology of biscuits, crackers and cookies, and of Dictionary of Food Ingredients.

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Negro teaches of wafers that can be filled and stacked (Column 2, lines 9-18). Negro also teaches wafer with good stability strength, smooth dense surface and can be used as filled wafer with two or more wafer sheets (column 2, lines 18-22) and has organoleptic properties along with delicacy and crispiness (column 1, lines 10-21). The wafers taught by Negro are 2.5 to 3 mm thin (Column 5, line 49) and can be made by including cocoa powder in the batter preferably about 1.5% by weight (Example, Column 4).

Negro teaches wafers with all the ingredients recited by the applicant in claims 6, 12, 13, 16 and 17. Negro teaches known batter recipes for wafers (Column 2, line 55 to column 3, line 14 and column 4, lines 55-68). The relative proportions of ingredients in wafer batter as taught by Negro are:

- Flour (total starch and flours) 30% (Recipe III, {(10Kg/33Kg) 100}) to 38.5% (Preferred wafer Example Column 4) to 40% ({(25Kg/62 Kg) 100} Recipes I and II), i.e., 30%-40% flour, which falls in the range recited by the applicant.
- Salt or cooking salt 0.08% ({(0.050Kg/62Kg) 100} Recipes I and II) to 0.1% (Example Column 4) and 0.106% ({(0.035Kg/33Kg) 100} Recipe III), i.e., 0.08%-0.11% Salt, which falls below the range recited by the applicant.
- Vegetable oil 0% (Recipe II), 0.3% ({(200g/62Kg) 100} Recipe I) to 0.15% (Recipe III {(50g/33Kg) 100}) and 2.5% (Example column 4 {(25g/1000g) 100}), i.e., Negro teaches a range of 0% to 2.5% oil, which falls in the range recited by the applicant.

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- Lecithin 0% (Recipe II), about 0.2%  $\{(100\text{g}/62\text{Kg})100\}$  Recipe I) to 0.15% (Recipe III  $\{(50\text{g}/33\text{Kg})100\}$ ) and 0.15% (Example column 4  $\{(24\text{g}/1000\text{g})100\}$ ), i.e., Negro teaches a range of 0% to about 0.2% lecithin, which falls in the range recited by the applicant.
- Sodium bicarbonate 0.04%  $\{(0.4\text{ g}/1000\text{g})100\}$  Example column 4), about 0.24%  $\{(150\text{g}/62\text{ Kg})100\}$  Recipe I) to 0.056% (Recipe II  $\{(35\text{g}/62\text{Kg})100\}$ ) and 0.22%  $\{(75\text{g}/33\text{Kg})100\}$  Recipe III), i.e., Negro teaches a range of 0.04% to about 0.2% of sodium bicarbonate, which falls in the range recited by the applicant. Also see Column 2, lines 27-31 and Column 3, lines 22-27. Cocoa powder 1.5%  $\{(15\text{ g}/1000\text{g})100\}$  Example column 4). Negro teaches about 2% of cocoa powder, which falls within the recited range of the applicant.
- Water 58%  $\{(36\text{Kg}/62\text{ Kg})100\}$  Recipes I and II) to 54%-60%  $\{(18-20/33)100\}$  Recipe III) and 56%  $\{(560\text{g}/1000\text{g})100\}$  Example in column 4), i.e., Negro teaches a range of 54%-60% of water, which encompasses the range recited by the applicant.

Negro teaches wafer compositions that contain flour, water, oil, sodium bicarbonate, lecithin and cocoa powder in the amounts recited by the applicant in claims 6, 12, 13, 16 and 17. Negro teaches a few examples of the wafer compositions (recipes) and in the examples the wafer composition comprises flour, water, vegetable oil, sodium bicarbonate, and lecithin. Some examples contain no oil and no lecithin and others do

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not contain cocoa powder, indicating that it is possible to make wafers with or without oil and cocoa powder and lecithin.

Lecithin is an emulsifier and also used as a wetting agent for cocoa powder (Page 83 Dictionary of food ingredients). The amount of lecithin needed in a batter would be variable based on the type and amount of the oils to be emulsified and other emulsifiers present in the composition. Technology of biscuits, crackers and cookies teaches wafer batter (Table 29.1, Page 294) recipes that contain lecithin in an amount of 0.3%  $\left(\left\{\frac{0.95\text{g}}{250\text{g}}\right\} 100\right)$  Recipe 4). Table 29.1 summarizes typical wafer recipes that are basic and general guidelines that can help in creation of a suitable batter based on personal preference (Also see pages 294-296). Therefore, wafer batters with lecithin levels in the recited range of the applicant have been known and it would have been obvious for one of ordinary skill in the art to modify Negro and add more lecithin to make the wafer batter more stable and help wet the dry ingredients, especially cocoa powder better.

Sodium bicarbonate or soda bicarb or soda is a well-known rising agent. Negro teaches the range of rising agents encompassing the recited range of the applicant. Negro further teaches that the general amount of rising agents and the composition of these agents varies considerably (column 2, lines 27-31).

Negro teaches a range of salt in the wafer recipe between 0.1 to 0.11%, which is lower than the recited range of the applicant. However, salt in a wafer batter is primarily added to enhance the flavor (Technology of biscuits, crackers and cookies, page 295), therefore adding salt in slightly different amounts in order obtain the desired flavor,

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would be considered as art recognized variable and applicant's intended function would have been obvious. Since Negro teaches all the ingredients in the recited range except for the amount of salt, therefore, it would have been obvious to the one with ordinary skill in the art at the time of the invention to modify Negro and add more salt in the wafer recipe to enhance the flavoring to the desired level as salt, sugar and cocoa powder in a primarily bland wafer batter stabilize and enhance the flavor and provide a longer shelf life. Furthermore, Further, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a co action or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Regarding claim 12, Negro does not specifically state the viscosity of the batter.

However, Negro teaches of a similar composition and wafer thickness as claimed by the

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applicant. Since the wafer batter composition taught by Negro is similar to the one taught by the applicant it would inherently have the viscosity recited by the applicant.

Applicant is reminded that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, applicant has chosen to use parameter that cannot be measured by the Office, for the purpose of prior art comparison, because the office is not equipped to manufacture prior art products and compare them for patentability. Therefore, as a prima facie case of obviousness has been properly established, the burden is shifted to the applicant to show that the prior art product is different.

Regarding claims 10, 11, 16 and 20 Negro also teaches wafers coated with chocolate or other coating compositions (column 1, lines 49-50 and 64-67 and column 2). The wafer recipe taught by Negro comprises of water, flour, salt, vegetable oil, lecithin, bicarbonate, cocoa powder and water (column 2, line 26 to column 5, line 6). Negro also teaches thin smooth wafer where two or more sheets that are bonded to one another by filling to make a sandwich (column 1, line 64 to column 2 line 25).



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Regarding claims 21 –23, Negro teaches a single wafer size of 90mm X 25 mm X 2-5 mm (column 6, Table) and also teaches filling and stacking of wafers in two or more sheets as discussed above, thus if the wafer sheets are 2-5 mm thick and so is the cream filling, then 3-6 layered wafer stack would have the dimension claimed by the applicant. Therefore Negro teaches a single wafer size of 90mm X 25 mm, which has the same length as claimed by the applicant, however the claimed width is about 30mm.

Regarding the width and the thickness of cream filled wafer stack, wafers in various shapes and sizes have been known in the art. Thus cutting wafer sheets in a different size or stacking wafer sheets in a stacks of 3 layers or 5 or 7 layers would not have involved an inventive step, and does not provide patentable distinction to the claims.

Thus, the claimed invention would have been obvious over Negro, absent any clear and convincing evidence and/or arguments to the contrary. Also see MPEP 2144.04 IV A, which outlines that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed subject matter and a product having the claimed relative dimensions would not perform differently than the prior art product, the claimed device is not patentably distinct from the prior art device.

Since Negro makes a wafer product containing cocoa powder that may be filled, stacked and enrobed in chocolate and produced in desired thickness range and trimmed to final dimensions in the approximate size claimed, therefore it would have been obvious to one of ordinary skill in the art at the time of the invention that Negro teaches the invention recited in claims 6, 10-13, 16-17, 20-23.

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(B) Claims 8-9, 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Negro (US 4629628) in view of the combination of Technology of biscuits, crackers and cookies, and of Dictionary of Food Ingredients Industry as applied to claims 6, 10-13, 16-17, 20-23 above, further in view of Eiji Ito et al (JP05-316930).

Negro teaches several wafer compositions and one with cocoa powder in the amount of about 2% by weight which falls in the lower end of the recited range of the applicant in the above mentioned claims.

Eiji Ito et al, hereinafter Ito, teaches wafer filling shells made with cocoa powder in the batter composition. Ito teaches a method of making wafer containers with 10-60 parts of cocoa powder and emulsifier in 100 parts of flour, makes a filling shell with strong cocoa flavor, uniform color and is appropriate for loading with foods containing high moisture content (Paragraphs 0001 to 0004 and 0007). Ito teaches using lecithin as the emulsifier (Paragraph 0011-0012) and wheat flour and water as the main ingredients. In an example taught by Ito, water constitutes about 55%  $\left(\frac{4800}{8700} \times 100\right)$  Example on page 4, translation), flour about 30%  $\left(\frac{2600}{8700} \times 100\right)$ , cocoa powder is about 6%  $\left(\frac{600}{8700} \times 100\right)$ . Thus Ito teaches the wafer shells made with about 6% cocoa powder as recited by the applicant in claims 6, 8, 9, and 13-19. Ito further teaches the wafer confection shell made with higher cocoa content not only provided the enhanced flavor of cocoa but also showed resistance to absorb moisture and maintained the crunchy light texture when stored in the freezer for three months with ice cream filled in it (Paragraph 0016).

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Wafers containing cocoa powder have been known in the art (Negro). Wafer batters have also been known to produce edible containers such as cones and cups for frozen confections. Edible containers with varying amounts of cocoa powder in the composition have also been known in the art (Ito). Cocoa powder in the wafer batter composition has been known to increase the shelf life of the wafer product by reducing moisture absorption from the environment (Ito). Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Negro and add more cocoa powder to the batter composition for making of the wafer product with about 6% of cocoa powder as taught by Ito in order to enhance the flavor and color of the wafer product. One would have been further motivated to do so in order to make the wafers with added crunchiness to the texture and an increased shelf life of the wafer product as taught by Ito which is also the intent of the applicant.

### ***Response to Arguments***

A certified copy of the EPO 02019145.8 application as required by 35 U.S.C. 119(b) has been received on July 31, 2006.

Applicant's arguments filed 2/14/05 have been fully considered but they are not persuasive.

Applicant's argument regarding Negro not teaching a wafer batter recipe with 2-10% cocoa powder has been considered and responded in the office action above.

Negro teaches a few examples of the wafer compositions (recipes) and in the examples the wafer composition comprises flour, water, vegetable oil, sodium bicarbonate, and

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lecithin. Some examples contain no cocoa powder, indicating that it is possible to make wafers with or without cocoa powder. Therefore Negro teaches that it is possible to add cocoa powder to enhance the flavor in any wafer batter. Further Ito teaches edible receptacles made with wafer composition with about 6% cocoa powder thus it has been known to add cocoa powder to wafer compositions. See above.

Applicant's argument regarding the viscosity has been considered and responded to in the office action above.

Applicant's argument regarding the amount of lecithin and sodium bicarbonate has been considered and responded to in the office action above. Regarding the argument that Negro does not teach cocoa powder in the recipe II, where the sodium bicarbonate is in the recited range of the applicant. The applicant is reminded that Negro teaches that cocoa powder can be added to wafer batter to enhance the color and flavor, therefore, the teaching of addition of cocoa powder in a batter applies to all wafer batter compositions taught by Negro. Thus all the wafer recipes as taught by Negro could contain cocoa powder, if desired.

Applicant's argument regarding the amount of salt has been considered and responded to in the office action above.

#### **Remarks/ Conclusion**

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jyoti Chawla  
Examiner  
Art Unit 1761

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**